



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Atty. Ref. No. 016781/0626

VINA SAN PEDRO, S.A.)

Opposer,)

v.)

FINANCIERE VRANKEN)

Applicant.)

Opposition No. 91110,853

75161464

**APPLICANT'S BRIEF IN OPPOSITION TO OPPOSER'S MOTION FOR AN
EXTENSION OF TESTIMONY PERIODS**

Applicant hereby opposes Opposer's Motion for an Extension of Testimony Periods ("Opposer's Motion") as follows.

Opposer's motion is misleading, since it could be mistakenly construed as representing that Applicant only recently notified Opposer that settlement of this case was not possible. This is not the case. In fact, as discussed below, since the final suspension period ended on December 17, 2003, the delay in moving forward lies squarely with Opposer.

In its motion, Opposer states:

The parties have been negotiating to try to settle this opposition for several years. The undersigned was notified on November 15 2004, that settlement was not possible, and that settlement was not likely, and to proceed with the opposition. As this notice was received only ten days before Opposer's testimony period closed on November 25, 2004, and extension of time is necessary to enable Opposer to put on its case, which will most likely be through deposition on written questions.

Opposer's Motion, p. 1. What Opposer fails to reveal is that Opposer's counsel was notified by its own client that settlement was not likely. Indeed, as explained below, with respect to



12-07-2004

settlement discussions, the ball had been Opposer's court since March 15, 2004. Moreover, substantive settlement negotiations had long since broken down. The only proposal on the table, a proposal suggested by Applicant, was that the parties agree to the withdrawal without prejudice of both the application and the opposition. There is no excuse for Opposer to have brought this opposition and then to ignore this matter until a mere ten days before the close of its own testimony period. Nothing precludes Opposer from presenting live oral testimony. If Opposer made the tactical decision to provide its testimony through depositions on written questions, rather than live oral testimony subject to contemporaneous cross-examination, then it was incumbent upon Opposer to prepare and schedule its testimony in a manner that would accommodate depositions on written questions. Opposer's belated request for an extension is an attempt to manipulate the situation to its advantage and should be denied.

Finally, Opposer's statement in its motions that "this motion is not made for purposes of delay, but rather, to enable the parties time to put on their testimony" is misleading. Applicant neither requires nor seeks any extension of its testimony period. In fact, prior to the filing of this motion for an extension by Opposer, Applicant expressly declined to consent to an extension.

The relevant facts are as follows:

1. The Notice of Opposition was filed on June 18, 1998 and the Board order instituting proceedings was mailed on June 30, 1998.
2. By agreement of the parties, proceedings were subsequently suspended on multiple occasions in order to explore the prospects of settlement.
3. On December 17, 2003, the final suspension period ended and the Board issued an order re-instituting proceedings. The Board order set a discovery cut-off deadline of March 17, 2004 and set the close of Opposer's testimony period for June 15, 2004.
4. Pursuant to Applicant's February 17, 2004 motion, Applicant's time to file an Answer was extended until March 16, 2004. Additionally, the discovery deadline was extended

to April 16, 2004 and the close of Opposer's testimony period was extended to July 14, 2004.

5. In an email to Opposer's counsel dated March 15, 2004, Applicant's counsel inquired whether Opposer would agree to withdrawal of application without prejudice in lieu of a settlement agreement. Exhibit A.
6. On March 16, 2004, Applicant timely filed its Answer to the Notice of Opposition.
7. In a letter to Opposer's counsel dated March 16, 2004, Applicant's counsel forwarded a service copy of Applicant's Answer and again proposed that the parties resolve the opposition by simply agreeing to the withdrawal without prejudice of both the application and the opposition. Exhibit B.
8. In a letter to Opposer's counsel dated April 26, 2004, Applicant's counsel inquired as to Opposer's position with respect to Applicant's proposal that the parties agree to the withdrawal without prejudice of both the application and the opposition. Exhibit C.
9. On April 27, 2004, the Board vacated a notice of default that had issued erroneously, and in so doing also reset the close of discovery to August 27, 2004 and reset close of Opposer's testimony period to November 25, 2004.
10. On August 27, 2004 the discovery period ended without Opposer initiating any discovery whatsoever. On that date, Opposer still had not responded to Applicant's March 15, 2004 proposal that the parties agree to the withdrawal without prejudice of both the application and the opposition.
11. In a November 16, 2004, telephone call to Applicant's counsel, Opposer's counsel indicated that it had been instructed by its client, the Opposer, to proceed with the opposition. Opposer's counsel also requested an extension of the testimony deadlines. At that time, Opposer still did not respond to Applicant's long outstanding proposal that the parties simply agree to the withdrawal without prejudice of both the application and the opposition.
12. In view of Opposer's failure to respond to Applicant's long outstanding proposal for a "without prejudice" termination of the case, Applicant declined to consent to a further extension of the trial schedule. Exhibit D. Opposer then filed the unconsented motion presently before the Board.

As reflected above, Opposer has effectively ignored this case since proceedings resumed in December, 2003. Opposer allowed the discovery period to close on two separate occasions without initiating any discovery whatsoever. During that time, Opposer also failed to respond to Applicant's proposal, outstanding since April 15, 2004 and reiterated by Applicant on several occasions, that the parties agree to withdrawal without prejudice of both the application and the opposition. Opposer ignored Applicant's proposal for six months.

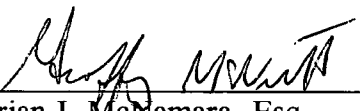
Then, with only ten days left in its testimony period, Opposer sought an extension of its trial schedule on the grounds that "the undersigned [counsel for Opposer] was notified on November 15, 2004 that settlement was not possible" and that such "notice was only received ten days before Opposer's testimony period closes." Opposer's motion for an extension is completely silent as to Opposer's prior failure to prosecute its case and misleadingly fails to state that it was Opposer who belatedly notified its own counsel that settlement was not possible.

WHEREFORE, Applicant requests that the Opposer's Motion for an Extension of Testimony Periods be denied. Alternatively, if the Board deems an extension to be warranted, then Applicant requests that Opposer be granted no further extensions in this case without the prior consent of the Applicant.

Respectfully submitted,

ATTORNEYS FOR APPLICANT

Date: December 7, 2004

By: 

Brian J. McNamara, Esq.
Geoffrey M. McNutt, Esq.
Foley & Lardner LLP
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5109
(202) 672-5300

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing APPLICANT'S BRIEF IN OPPOSITION TO OPPOSER'S MOTION FOR AN EXTENSION OF TESTIMONY PERIODS was served on Opposer, by mailing the same, via first class mail, postage prepaid, this 7th day of December, 2004, to Opposer's counsel, addressed as follows

Cynthia Clarke Weber, Esq.
Sughrue Mion PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213



Angelina Mejia
Foley & Lardner LLP

EXHIBIT A

McNutt, Geoffrey M.

From: McNutt, Geoffrey M.
Sent: Monday, March 15, 2004 2:01 PM
To: Cindy Weber (cweber@sughrue.com)
Subject: SAO PEDRO Opposition

Vina San Pedro SA v. Financiere Vranken
Opposition No. 110,853

Dear Cindy,

In lieu of a settlement agreement, our client wishes to know whether Vina San Pedro will consent to our client's withdrawal of its U.S. Application Serial No. 75/161464 without prejudice.

Best regards,

Geoffrey McNutt
Foley & Lardner LLP
Washington Harbour
3000 K Street, N.W.
Suite 500
Washington, D.C. 20007-5109
TEL: 202-945-6120
FAX: 202-672-5399
gmcnutt@foley.com

EXHIBIT B



**FOLEY & LARDNER LLP
ATTORNEYS AT LAW**

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CLIENT/MATTER NUMBER
016781-0626

March 16, 2004

Cynthia Clarke Weber, Esq.
SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213

VIA FACSIMILE 202-293-7860 & U.S. MAIL

Re: U.S. Application No. 75/161,464 for SAO PEDRO DAS
AGUIAS PORTO RUBY SUPERIOR PREMIUM QUALITY,
Opposition Proceeding 91110853
Our Ref.: 016781/0626
Your Ref.: 200-663

Dear Cindy:

This letter is further to my e-mail of yesterday concerning this matter. Enclosed with this letter is a service copy of the Answer to Notice of Opposition.

As we previously discussed, it was agreed that in exchange of our client withdrawing its application without prejudice, your client would withdraw its opposition without prejudice.

Sincerely,

Geoffrey M. McNutt

Enclosure

cc: Brian J. McNamara, Esq.

EXHIBIT C

FOLEY

COPY

April 26, 2004

**FOLEY & LARDNER LLP
ATTORNEYS AT LAW**

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CLIENT/MATTER NUMBER
016781-0626

Cynthia Clarke Weber, Esq.
SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037

Re: U.S. Application No. 75/161,464
Mark: SAO PEDRO DAS AGUIAS PORTO RUBY
SUPERIOR PREMIUM QUALITY
Opposition Proceeding No. 91110853
Our Ref.: 016781/0626
Your Ref.: 200-663

Dear Cindy:

As you may already know, the Board apparently lost my client's answer in this case. As a result, the Board erroneously issued a show cause order dated April 20, 2004. Enclosed for your files is a copy of Applicant's Response to the Show Cause Order, which was filed with the TTAB today via facsimile.

Also, please let me know whether your client has provide you with its position regarding our most recent settlement proposal. Specifically, please confirm whether your client will agree to consent to my client's withdrawal of its U.S. Application Serial No. 75/161,464 without prejudice. In exchange, my client would agree to consent to withdrawal of the present opposition without prejudice.

Sincerely,



Geoffrey M. McNutt

GMM/RAW

Enclosure

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SAN DIEGO/DEL MAR
SAN FRANCISCO
TALLAHASSEE

TAMPA
WASHINGTON, D.C.
WEST PALM BEACH

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EXHIBIT D



FOLEY & LARDNER LLP
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November 18, 2004

VIA FACSIMILE AND U.S. MAIL

WRITER'S DIRECT LINE
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CLIENT/MATTER NUMBER
016781-0626

Cynthia Clarke Weber, Esq.
SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037

Re: U.S. Application No. 75/161,464
Mark: SAO PEDRO DAS AGUIAS PORTO RUBY
SUPERIOR PREMIUM QUALITY
Opposition Proceeding No. 91110853
Our Ref.: 016781/0626
Your Ref.: 200-663

Dear Cindy:

My client wishes to bring this matter to a conclusion. Thus, I am not authorized to consent to an extension of the testimony schedule.

I do have authorization to settle this case on a "walk-away" basis without prejudice to either party. If Vina San Pedro will consent to withdrawal of the application without prejudice, then my client will consent to withdrawal of the opposition without prejudice.

Sincerely,

Geoffrey M. McNutt

BRUSSELS
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